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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,266	10/29/2001	John D. Smith	PC-1059CIP	4315

23717 7590 05/07/2004

LAW OFFICES OF BRIAN S STEINBERGER  
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EXAMINER

STORMER, RUSSELL D

ART UNIT PAPER NUMBER

3617

DATE MAILED: 05/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,266

Applicant(s)

SMITH, JOHN D.

Examiner

Russell D. Stormer

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 9-11 and 13-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13, 14 and 19 is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 15-18 and 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. The indicated allowability of certain claims in the previous office action is withdrawn in view of the newly discovered references. Rejections based on the newly cited references follow.
2. Claim 8 is not submitted in the response filed January 20, 2004. It is not clear if this claim was intended to be amended or cancelled. Accordingly, claim 8 cannot be examined on the merits and is presumed to be cancelled.

***Specification***

3. The disclosure is objected to because of the following informalities: In line 17 of page 12, the word - -include- - should be inserted after "can."

Appropriate correction is required.

***Claim Objections***

4. Claims 2, 3, 15-18, 24, and 25 are objected to because of the following informalities: Each of the independent claims sets forth a wheel cover in the preamble, but the body of the claim, or the independent claims further set forth a stencil and a marker, or a specific type of vehicle. It is not clear if Applicant intends to claim the combination or the subcombination of elements in the claims.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 21, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lyon '755.

The blank outer surface 16 of the cover of Lyon '755 (newly cited) has a washable material; and being blank, the outer surface would allow a user to apply an indicia.

7. Claims 1, 15, 16, 21, and 22 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Braucher (newly cited).

Note lines 36-44, which state that the cover may be washed.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Braucher.

To use stencils and a marker for applying the indicia to the cover of Braucher would have been obvious as stencils and markers are notoriously well-known for making signs and other printed matter.

10. Claims 1, 2, 3, 9-11, 15-18, 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nosler in view of Braucher.

Nosler discloses a wheel cover made of a thin rigid pliable and washable material (Mylar backed by a cloth) which can be attached and removed from a vehicle wheel by gluing thereto. The cover is perforated to allow the wheel hub or valve stem to project through. The wheel cover is not disclosed as allowing indicia to be applied and removed.

Braucher teaches a wheel cover in which indicia may be applied and then removed so that a different indicia may be applied. From this teaching it would have been obvious to one of ordinary skill in the art to apply indicia to the cover of Nosler in a way that it could be removed later so that the cover could be customized to a particular purpose or desire.

To use a stencil and/or marker to apply the indicia to the cover would have been obvious to anyone of ordinary skill in the art as stencils and markers are well-known for their ease of use and universal availability.

To ally the cover to a certain type of vehicle would have been obvious as an intended use.

11. Claims 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pollock in view of Mazzerole (both newly cited).

To apply the indicia on the cover of Pollock by attaching a sticker would have been obvious as taught by Mazzerole.

***Allowable Subject Matter***

12. Claims 19, 13, and 14 are allowable over the prior art of record.

***Response to Arguments***

13. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The prior art shows other wheel covers, many of which have indicia, all of which are washable and capable of receiving a form of indicia.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Russell D. Stormer whose telephone number is (703) 308-3768. The examiner can normally be reached on Monday through Friday, 9 AM to 4 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joe Morano can be reached on (703) 308-0230. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3617

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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5/3/04

  
RUSSELL D. STORMER  
PRIMARY EXAMINER 5/3/04